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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/813,234	03/31/2004	Scott Hamilton	52493.000366	3879

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EXAMINER

KANG, ROBERT N

ART UNIT	PAPER NUMBER
2625	

DATE MAILED: 12/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/813,234

Applicant(s)

HAMILTON ET AL.

Examiner

Robert N. Kang

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 and 41-43 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-22 and 41-43 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 3/31/2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

DETAILED ACTION***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claim 1 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of prior U.S. Patent No. 6,799,150.

Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 1 of the pending application is merely claim 1 of the '150 patent repeated *verbatim*, with the exception that two limitations have been removed.

The removal of an element or its function is obvious (See MPEP § 2144 II A). This rationale is applied to all the following obviousness type double patenting rejections unless specifically stated otherwise.

2. Claim 2 rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of prior U.S. Patent No. 6,799,150.

Although the conflicting claims are not identical, they are not patentably distinct from each other because storing log files in a restricted-access database or file/directory was a well-known technique at the time of invention (official notice).

The motivation of this modification would be to prevent user alteration or access of sensitive administrative log files.

Therefore it would have been obvious to modify claim 1 of the '150 patent to "store the log files in a restricted database for controlling access."

3. Claim 3 rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 (col. 7, lines 21-22) of prior U.S. Patent No. 6,799,150.

4. Claim 7 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 2 of prior U.S. Patent No. 6,799,150. Additionally, claim 42 is merely the first 13 lines of claim 7, and therefore claiming essentially the same invention of claim 7. Finally, claim 41 is merely the first 7 lines of claim 42; therefore it is claiming essentially the same invention.

5. Claim 8 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 2 (col. 7, lines 63-65) of prior U.S. Patent No. 6,799,150.

6. Claim 9 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 2 of prior U.S. Patent No. 6,799,150. Claim 4 (col. 8, lines 51-54) is the counterpart method claim for the system claim 2 of the '150 patent which includes the step of "parsing the log files to retrieve system data, and storing the retrieved system data for later retrieval and analysis." Clearly, this function must be executed by some means, and thus it would have been obvious to include in claim 2 a "parsing engine which parses the log files into retrievable data which is then stored for later retrieval and analysis."

7. Claim 10 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 2 (col. 7, lines 57-58) of prior U.S. Patent No. 6,799,150.

8. Claim 20 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 3 of prior U.S. Patent No. 6,799,150.

9. Claim 21 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 3 (col. 8, lines 22-23) of prior U.S. Patent No. 6,799,150.

10. Claim 22 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 3 (col. 8, lines 23-26) of prior U.S. Patent No. 6,799,150.

11. Claim 43 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 4 (col. 8, lines 31-41 and 44-46) of prior U.S. Patent No. 6,799,150.

12. Claims 5 and 12 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 13 of U.S. Patent No. 6,799,150. Although the conflicting claims are not identical, they are not patentably distinct from each other because the "failed e-mail monitoring system" is responsible for "detecting the failed delivery of notices." Therefore, it is obvious that the failed e-mail system itself could reasonably create the log files, which is identical to claims 5 and 12, "wherein at least one of the log files are created within the failed e-mail monitoring system."

13. Claims 6 and 13 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 14 of prior U.S. Patent No. 6,799,150.

14. Claim 14 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 13 of U.S. Patent No. 6,799,150. Although the conflicting claims are not identical, they are not patentably distinct from each other because the "failed e-mail monitoring system" is responsible for "detecting the failed delivery of notices." Therefore, it is obvious that the failed e-mail system itself could reasonably create the log files, which is identical to claims 5 and 12, "wherein at least one of the log files are created within the failed e-mail monitoring system."

15. Claim 15 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 16 of prior U.S. Patent No. 6,799,150. The claim, while directed towards a method as opposed to a system, is repeated verbatim.

16. Claim 16 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 17 of prior U.S. Patent No. 6,799,150. Although the conflicting claims are not identical, they are not patentably distinct from each other because, while claim 17 of the '150 patent pertains to a method and therefore does not expressly disclose *where* the log file is generated, it is obvious that a log file may be generated in any storage element of the document delivery system.

17. Claim 17 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 18 of prior U.S. Patent No. 6,799,150. The claim, while directed towards a method as opposed to a system, is repeated verbatim.

18. Claim 18 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 19 of prior U.S. Patent No. 6,799,150. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 18 discloses creating the log file "as part of providing Internet access to the documents and document data accepted for document delivery" as a method step; the counterpart system means (claim 2) provides "an internet server, wherein the Internet server provides on-line access to the document data and electronic documents." Therefore, it would have been obvious to create the log file in the actual element providing the Internet access, as disclosed in claim 19.

19. Claim 19 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 20 of prior U.S. Patent No. 6,799,150. The claim, while directed towards a method as opposed to a system, is repeated verbatim.

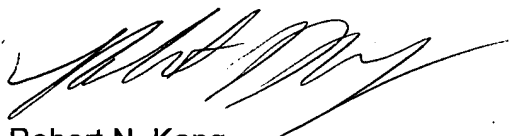
Conclusion

This action is NON-FINAL.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert N. Kang whose telephone number is 571-272-0593. The examiner can normally be reached on M-F 9-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Twyler M. Lamb can be reached on (571)272-7406. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Robert N. Kang



TWYLER LAMB
SUPERVISORY PATENT EXAMINER